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22428	7590	08/10/2005	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			WYATT, KEVIN S	
			ART UNIT	PAPER NUMBER
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DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/743,491

Applicant(s)

ICHIYANAGI, TOSHIMITSU

Examiner

Kevin Wyatt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1203.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

2. Claims 3-4, 6, and 10-12 are objected to because of the following informalities:

In claim 3, line 7, "optically" should be changed to --optical--.

In claim 3, line 8, "electronic" should be changed to --electric--.

In claim 4, line 12, "inputted" should be changed to --input--.

In claim 6, line 2, "comprising" should be changed to --comprising:--.

In claim 10, line 6, "of the original" should be changed to --the surface of the original--.

In claim 11, line 2, "comprising" should be changed to --comprising:--.

In claim 12, line 2, "comprising" should be changed to --comprising:--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 15-17, the phrase "reads electric data recorded in a memory in the IC chip built in the original, by the radio communication unit " is unclear. It is unclear whether the control unit reads electric data or records (writes) electric data in to memory, or if these functions are performed by the radio communication unit. Further clarification of this limitation is required.

In claim 4, lines 14-16, the phrase "records the image data as electric data, by the radio communication unit, in a memory in the IC chip embedded in the image forming medium." is unclear. It is unclear whether the control unit records the image data or the radio communication unit performs this function. Further clarification is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Shinoda (Publication No. U.S. 2003/0133153 A1). Insofar as understood.

Regarding claim 1, Shinoda shows in Fig. 1, a scanner (71, i.e., reader terminal) comprising: an optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) which optically scans a surface of an original (25, i.e., recording medium) and converts an image on the surface of the original (25, i.e., recording medium) into image data (35 i.e., recorded information of a file, paragraph 0020, line 11); a radio communication unit (i.e., wireless network, paragraph 0023, line 7) which, at the time of scanning the original (25, i.e., recording medium) in which an IC chip (45, i.e., contactless IC chip) having a radio communication function has been embedded (receives power and read out data from printer (60) and reader terminal (71) via antenna, paragraph 0024, lines 3-5), by the optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9), carries out radio communication with the IC chip (45, i.e., contactless IC chip) (terminal (70) sends information obtained by terminal (71) (via wireless network) to managing server (10), paragraph 0020, lines 1-5 and 13-15); and a control unit (10, i.e., managing server) which optically scans the surface the original (25, i.e., recording medium) by the optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) and converts the image on the surface of the original (25, i.e., recording medium) into image data (reads document image data and puts a digital signature and then sends the data to managing server, paragraph 0030, lines 10-15) when scanning of the original (25, i.e., recording medium) in which the IC chip (45, i.e., contactless IC chip) having a radio communication function has been embedded is requested, and reads in a memory (read-only or electrically erasable programmable, paragraph 0024, lines 5-8) in the IC

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chip (45, i.e., contactless IC chip) built electric data (35, i.e., document) recorded in the original, by the radio communication unit (i.e., wireless network, paragraph 0023, line 7).

Regarding claim 2, Shinoda shows in Fig. 1 a scanner according to claim 1, wherein the control unit (10, i.e., managing server) further records additional information (document authentication request sent to server, paragraph 0030, lines 14-15 and paragraph 0031 lines 1-2) showing contents of processings with respect to the original (25, i.e., recording medium) in the memory in the IC chip (45, i.e., contactless IC chip) built in the original (25, i.e., recording medium), by the radio communication unit (i.e., wireless network, paragraph 0023, line 7), at the time of scanning the original (25, i.e., recording medium) which the IC chip (45, i.e., contactless IC chip) having a radio communication function has been embedded.

Regarding claim 3, Shinoda shows in Fig. 1 a scanner according to claim 1, further comprising: a network interface (i.e., network (having wireless communication functions), paragraph 0023, line 7) which carries out data communication with an external device (the network to establish desired connections between the managing server (10), the ID managing center (50), the printer (60), and terminal (70), paragraph 0023, lines 1-3), wherein the network interface respectively transfers the image data (35, i.e., document) obtained by optically scanning the surface of the original (25, i.e., recording medium) by the optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) and the electronic data (35, i.e., document) read from the memory (read-only or electrically erasable programmable, paragraph 0024, lines 5-

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8) in the chip embedded in the original (25, i.e., recording medium) by the radio communication unit (wireless network) to the external devices.

Regarding claim 4, Shinoda shows in Fig. 1, a printer comprising: an image forming unit (60, i.e., printer) which prints an image on a surface of an image forming medium (20, i.e., recording medium); a radio communication unit (i.e., wireless network) which, at the time of printing an image on the image forming medium (20, i.e., recording medium) in which an IC chip having a radio communication function embedded (40 i.e., Radio Frequency Identifier chip including an antenna therein, paragraph 0024, lines 1-3), by the image forming unit (60, i.e., printer), carries out radio communication with the IC chip (40, i.e., RFID chip); and a control unit which (10, i.e., managing server), when image data (30, i.e., document) to be printed on the image forming medium (20, i.e., recording medium) in which the IC chip (40, i.e., RFID chip) having a radio communication function has been embedded is input thereto, prints an image based on the image data (30, i.e., document) on the image forming medium (20, i.e., recording medium) by the image forming unit (60, i.e., printer), and records the image data (30, i.e., document) as electric data, by the radio communication unit (wireless network), in a memory (read-only or electrically erasable programmable, paragraph 0024, lines 5-8) in the IC chip (40, i.e., RFID chip) embedded the image forming medium (20, i.e., recording medium) (paragraph 0014, lines 7-11).

Regarding claim 5, Shinoda shows in Fig. 1, a printer according to claim 4 wherein, at the time of carrying out printing on the image forming medium (20, i.e., recording medium) by the image forming unit (60, i.e., printer), the control unit (10, i.e.,

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managing server) further records additional information showing contents of processings (i.e., document authentication request sent to server, paragraph 0030, lines 14-15 and paragraph 0031 lines 1-2) with respect to the image forming medium (20, i.e., recording medium) by the radio communication unit (i.e., wireless network), in the memory (read-only or electrically erasable programmable, paragraph 0024, lines 5-8) in the IC chip (40 i.e., RFID chip) embedded in the image forming medium (20, i.e., recording medium).

Regarding claim 6, Shinoda shows a printer according to claim 4, further comprising: a network interface (i.e., network (having wireless communication functions), paragraph 0023, line 7) which carries data communication with an external device (the network to establish desired connections between the managing server (10), the ID managing center (50), the printer (60), and terminal (70), paragraph 0023, lines 1-3), wherein when a request for printing received by the network interface (i.e., network(having wireless communication functions), paragraph 0023, line 7), the control unit (10, i.e., managing server) carries out printing of an image on the surface the image forming medium (20, i.e., recording medium) by the printer (60, i.e., printer) on the basis of print data (30, i.e., document) received from the external device (from terminal (70), database (11)) by the network interface (paragraph 0026, lines 8-16), and records electronic data for being wirelessly written received from the external device (from terminal (70), database (11)) by the network interface (i.e., network(having wireless communication functions)), in the memory (read-only or electrically erasable programmable, paragraph 0024, lines 5-8) in the IC chip (40 i.e., RFID chip) embedded

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in the image forming medium (20, i.e., recording medium) by the radio communication unit (i.e., communication section) (paragraph 0027, lines 1-9).

Regarding claim 7, Shinoda shows a copying machine comprising: an optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) which optically scans a surface of an original (25, i.e., recording medium), and converts an image on the surface of the original (25, i.e., recording medium) into image data (35 i.e., recorded information of a file paragraph 0020, line 10); an image forming unit (60 i.e., printer) which prints an image on a surface of an image forming medium (20, i.e., recording medium); a radio communication unit (i.e., wireless network) which carries out radio communication with an IC chip (45, i.e., contactless IC chip) embedded in the original (35, i.e., document) or the image forming medium (20, i.e., recording medium) and having a radio communication function; and a control unit (10, i.e., managing server) which carries out scanning of the original (25, i.e., recording medium) by the optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) or printing on the image forming medium (20, i.e., recording medium) by the image forming unit (60 i.e., printer), and carries out reading or writing of electronic data by the radio communication unit (i.e., wireless network) with respect to a memory in the IC chip (40 or 45, i.e., RFID chip) embedded in the original (25, i.e., recording medium) or the image forming medium (20, i.e., recording medium).

Regarding claim 8, Shinoda shows in Fig.1 a copying machine according to claim 7, wherein the radio communication unit (i.e., wireless network) carries out radio communication with the IC chip (45, i.e., contactless IC chip) at the time of scanning the

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original (25, i.e., recording medium) in which the IC chip (45, i.e., contactless IC chip) having a radio communication function has been embedded by the optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9), and the control unit (10, i.e., managing server) optically scans the surface of the original (25, i.e., recording medium) by the optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) and converts the image on the surface the original (25, i.e., recording medium) into image data (35, i.e., recording medium), and reads the electric data recorded in the memory in the IC chip (45 i.e., contactless IC chip) built in the original (25, i.e., recording medium) by the radio communication unit (i.e., wireless network), and prints the image on the surface of the image forming medium (20, i.e., recording medium) on the basis of the electric data (identification received from server (10) from both documents (30) and (35) (having IC's (40) and (45)) from printer (60) and terminal (70), paragraph 0013, lines 6-12) read from the memory (read-only or electrically erasable programmable, paragraph 0024, lines 5-8) in the IC chip (40 or 45, i.e., RFID chip) by the radio communication unit (i.e., wireless network).

Regarding claim 9, Shinoda shows in Fig. 1, a copying machine according to claim 7, wherein the radio communication unit (i.e., wireless network) carries out radio communication with the (40, i.e., RFID chip) IC chip at the time of printing of the image on the surface of the image forming medium (20, i.e., recording medium) which the IC chip (40 i.e., RFID chip) having a radio communication function has been embedded, by the image forming unit (60 i.e., printer), and the control unit (10 i.e., managing server) optically scans the surface of the original (25, i.e., recording medium) by the optical

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reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9), converts the image on the surface of the original (25, i.e., recording medium) into image data, and prints an image based on the image data on the surface of the image forming medium (20, i.e., recording medium) by the image forming unit (60 i.e., printer), and records the image data (30, i.e., document) as electronic data in the memory in the IC chip (40, i.e., RFID chip) embedded in the image forming medium (20, i.e., recording medium) by the radio communication unit (i.e. wireless network).

Regarding claim 10, Shinoda shows in Fig. 1, a copying machine according to claim 7, wherein the radio communication unit (wireless network) comprises a first radio communication unit (i.e., first portion of wireless network) which carries out radio communication with the chip (45 i.e., contactless IC chip) at the time of scanning, by the optical reading unit (i.e., a scanner function to acquire image data), the surface of the original (25, i.e., recording medium) which the IC chip (45, i.e., contactless IC chip) having a radio communication function has been embedded, and a second radio communication unit (i.e., second portion of wireless network) which carries out radio communication with the IC chip (40, i.e., RFID chip) at the time of printing, by the image forming unit (60 i.e., printer), of an image on the image forming medium (20, i.e., recording medium) in which the IC chip (40 i.e., RFID chip) having a radio communication function has been embedded, and the control unit (10, i.e., managing server) optically scans the surface of the original (25, i.e., recording medium) by the optical reading unit (i.e., a scanner function to acquire image data) and converts the image on the surface of the original (25, i.e., recording medium) into image data, and

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reads the electric data (35, i.e., document) recorded in the memory in the IC chip (45, i.e., contactless IC chip) built in the original (25, i.e., recording medium), by the first radio communication unit (i.e., first portion of wireless network), and prints an image on the surface of the image forming medium (20, i.e., recording medium) by the image forming unit (60 i.e., printer) on the basis of the electric data read from the memory in the IC chip of the original (45, i.e., contactless IC chip) by the first radio communication unit (i.e., first portion of wireless network), and records the electric data (i.e., identification received from server (10) from both documents (30) and (35) (having IC's (40) and (45)) from printer (60) and terminal (70), paragraph 0013, lines 6-12) read from the memory in the IC chip (45 and 40 i.e., RFID chip) by the first radio communication unit (i.e., first portion of wireless network) or by the second radio communication unit (i.e., second portion of wireless network), in the memory (read-only or electrically erasable programmable, paragraph 0024, lines 5-8) in the IC chip (40 i.e., RFID chip) embedded the image forming medium (20, i.e., recording medium).

Regarding claim 11, Shinoda shows in Fig.1, a copying machine according to claim 10, further comprising: a control panel (70 i.e., terminal) to which an instruction (i.e., query) from a user is input, wherein the control unit (10 i.e., managing server) selects whether data to be printed on the image forming medium (20, i.e., recording medium) as an image by the image forming unit (60 i.e., printer) is made to be the image data of the original (25, i.e., recording medium) acquired by the optical reading unit (i.e., a scanner function to acquire image data), or to be the electronic data (35 i.e., document) read from the memory (read-only or electrically erasable programmable,

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paragraph 0024, lines 5-8) in the IC chip (45, i.e., contactless IC chip) of the original (25, i.e., recording medium) by the first radio communication unit (i.e., first portion of wireless network), in accordance with the instruction of the user with respect to the control panel (70 i.e., terminal).

Regarding claim 12, Shinoda shows in Fig. 1, a copying machine according to claim 10 further comprising: a control panel (70, i.e., terminal) to which an instruction (i.e., query) from the user is input, wherein the control unit (10, i.e., managing server) selects whether data to be recorded by the second radio communication unit (i.e., wireless network) in the memory (read-only or electrically erasable programmable, paragraph 0024, lines 5-8) the IC chip (40, i.e., RFID chip) embedded the image forming medium (20, i.e., recording medium) is made to be the image data (35, i.e., document) of the original (25, i.e., recording medium) which the optical reading unit (i.e., a scanner function to acquire image data) acquired, or to be the electronic data (35, i.e., document) read from the memory (read-only or electrically erasable programmable, paragraph 0024, lines 5-8) in the IC chip (45, i.e., contactless IC chip) of the original (25, i.e., recording medium) by the first radio communication unit (i.e., first portion of wireless network), accordance with the instruction of the user to the control panel (70 i.e., terminal).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wilz (U.S. Patent No. 6,464,139 B1) discloses a Wireless Hand-Supportable Internet-Enabled Access Terminal For Enabling Information-Related Transactions Over the Internet.

Patel (Publication No. U.S. 2002/0163579 A1) discloses a Data Capture And Relay Device Including Camera and Physical Data Sensor.

Yoda (Publication No. U.S. 2003/0164974 A1) discloses an Information Conveyance System And Printing Medium Having IC Chips.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Wyatt whose telephone number is (571)-272-5974. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Porta can be reached on (571)-272-2444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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